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YORK.US.2

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EXAMINER

GILBERT, WILLIAM V

ART UNIT

PAPER NUMBER

3635

NOTIFICATION DATE

DELIVERY MODE

08/18/2010

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b> 10/710,845	<b>Applicant(s)</b> KOCH ET AL.	
	<b>Examiner</b> WILLIAM V. GILBERT	<b>Art Unit</b> 3635	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08 June 2010.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-10 and 17-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10, 17-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)                        | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

This is a non-final action after re-opening prosecution.

- Claims 1-10 and 17-27 are pending and examined.
- Claims 11-16 are cancelled.

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 1, 2, 4 and 8-10** are rejected under 35 U.S.C. 102(b) as being anticipated by Rizzo (U.S. Patent No. 3,497,417).

Claim 1: Rizzo discloses a combination through-wall masonry flashing / drainage device comprising a flashing membrane (Fig. 2: 34), the flashing membrane having a first side and a second side opposite the first side, a reinforcing cloth (36) adhered to the flashing membrane first side, and a wicking cloth (40, see Col. 4, lines 10-17 and Col. 3, lines 55-60, which notes that the material is a cotton cloth with asphalt) adhered to the flashing membrane second side. Applicant should respectfully

Art Unit: 3635

note that the cotton cloth acts functions as a wicking material in that it does absorb the asphalt.

Claim 2: Rizzo discloses the device of claim 1, wherein the flashing membrane is a sheet of copper material (Col. 4, lines 5-10).

Claim 4: Rizzo discloses the device of claim 1, wherein the reinforcing cloth is fiberglass (Col. 4, lines 10-15).

Claim 8: Rizzo discloses the device of claim 1, wherein the wicking cloth transports liquid by capillary action or fiber tow infiltration. The language of this claim is a statement of intended use of the claimed invention and must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Claim 9: Rizzo discloses the device of claim 8, wherein the wicking cloth transports liquid by both capillary action and gravity. The language of this claim is a statement of intended use of the claimed invention and must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Art Unit: 3635

Claim 10: Rizzo discloses the device of claim 1 further comprising an adhesive disposed between the reinforcing cloth and the flashing membrane (Col. 4, lines 10-15), and between the wicking cloth and the flashing membrane (Col. 3, lines 60-63).

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

**Claims 3 and 5** are rejected under 35 U.S.C. 103(a) as being unpatentable over Rizzo.

Claim 3: Rizzo discloses the device of claim 1, wherein the flashing membrane is made of copper sheet, but it does not disclose the copper sheet weighing between three and seven ounces per square foot and is between 0.0036 and 0.0094 inches thick. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to have this limitation because optimization of a limitation will not support patentability of subject matter encompassed by the prior art unless there is evidence indicating such a limitation is critical. See M.P.E.P. §2144.05 "[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." *In re Aller*, 220 F.2d 454 (CCPA 1955) (Claimed process which was performed at a temperature between 40C and 80C and an acid concentration between 25% and 70% was held to be *prima facie* obvious over a reference process which differed from the claims only in that the reference process was performed at a temperature of 100C and an acid concentration 10%.)

Claim 5: Rizzo renders obvious the device of claim 4, except wherein the reinforcing cloth weighs between 0.2 and 0.3 ounces per square foot. It would have been obvious at the time

Art Unit: 3635

the invention was made to a person having ordinary skill in the art to have this limitation because optimization of a limitation will not support patentability of subject matter encompassed by the prior art unless there is evidence indicating such a limitation is critical. See M.P.E.P. §2144.05 "[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." *In re Aller*, 220 F.2d 454 (CCPA 1955) (Claimed process which was performed at a temperature between 40C and 80C and an acid concentration between 25% and 70% was held to be *prima facie* obvious over a reference process which differed from the claims only in that the reference process was performed at a temperature of 100C and an acid concentration 10%.)

**Claims 6, 7 and 17-20** are rejected under 35 U.S.C. 103(a) as being unpatentable over Rizzo in view of Sourlis (U.S. Patent No. 6,023,892).

Claim 6: While Rizzo does disclose a wicking cloth as in claim 1, it does not disclose wherein the wicking cloth is made of a synthetic fiber material selected for maximum wicking ability, life expectancy, mildew resistance, and strength characteristics, is about 0.050 inches thick, and weighs between

Art Unit: 3635

five and seven ounces per square yard. Surlis discloses that it is known in the art to make such wicking material from cotton, or synthetics such as nylon (Col. 2, lines 10-15, while a synthetic is not a preferred material, it is known in the art to use it.) It would have been obvious at the time the invention was made to a person having ordinary skill in the art to use nylon as a wicking material as it would perform as needed as a wicking material and would absorb the asphalt mixture as in Rizzo properly. With respect to the specifications of the wicking material, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to have this limitation because optimization of a limitation will not support patentability of subject matter encompassed by the prior art unless there is evidence indicating such a limitation is critical. See M.P.E.P. §2144.05 "[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." *In re Aller*, 220 F.2d 454 (CCPA 1955) (Claimed process which was performed at a temperature between 40C and 80C and an acid concentration between 25% and 70% was held to be *prima facie* obvious over a reference process which differed from the claims only in that the reference process was



Art Unit: 3635

performed at a temperature of 100C and an acid concentration 10%.)

Claim 7: Rizzo in view of Sourlis renders obvious the device of claim 1, except wherein the wicking cloth material is one taken from the group consisting of polyester, polypropylene, polypropylene nylon, and polyethylene, though Sourlis notes that nylon can be used. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to make the wick from a material such as polypropylene nylon, as polypropylene nylon is a type of nylon, which is disclosed in Sourlis and it would perform adequately as needed with the system in Rizzo in view of Sourlis.

Claim 17: Rizzo discloses a combination through-wall masonry flashing / drainage device comprising: a flashing membrane (Fig. 4: 60), the flashing membrane having a first side and a second side opposite the first side, a first reinforcing cloth (66) adhered to the flashing membrane first side, a second reinforcing cloth (80) adhered to the flashing membrane second side. The embodiment in Fig. 4 does not disclose the wicking cloth layer, however, the embodiment in Fig. 2 discloses a wicking cloth (38; see Col. 4, lines 10-15 and Col. 3, lines 55-60) adhered to the reinforcing cloth. It would have been obvious at the time the invention was made to a person having

Art Unit: 3635

ordinary skill in the art to have the wicking cloth with the embodiment in Fig. 4 as the embodiments are obvious variants and the materials can be interchanged without departing from the scope of the prior art. Further, Rizzo does not disclose wherein the wicking cloth material is selected from the group consisting of polyester, polypropylene, polypropylene nylon, and polyethylene. Sourlis discloses that it is known in the art to make such wicking material from cotton, or synthetics such as nylon (Col. 2, lines 10-15, while a synthetic is not a preferred material, it is known in the art to use it.) It would have been obvious at the time the invention was made to a person having ordinary skill in the art to use nylon as a wicking material as it would perform as needed as a wicking material and would absorb the asphalt mixture as in Rizzo properly. Further, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to make the wick from a material such as polypropylene nylon, as this is a type of nylon, which is disclosed in Sourlis and it would perform adequately as needed with the system in Rizzo in view of Sourlis.

Claim 18: The combination of the prior art provides the device of claim 17, wherein the wicking cloth transports liquid by capillary action or fiber tow infiltration. The language of

Art Unit: 3635

this claims is a statement of intended use of the claimed invention and must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Claim 19: The prior art provides the device of claim 18, wherein the wicking cloth also transports liquid by gravity. The language of this claim is a statement of intended use of the claimed invention and must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Claim 20: The prior art provides the device of claim 17 further comprising an adhesive disposed between the reinforcing cloths and the flashing membrane (Col. 4, lines 10-15), and between the wicking cloth and the reinforcing cloth (Col. 3, lines 60-63).

**Claims 21-27** are rejected under 35 U.S.C. 103(a) as being unpatentable over Rizzo in view of Collins (U.S. Patent No. 6,964,136).

Claim 21: Rizzo discloses a system for removing water from between an inner wall and an outer wall through-wall masonry flashing and drainage device, the device comprising a flashing membrane (Fig. 2: 34) having a first side and a second side opposite the first side, a reinforcing cloth (36) adhered to the flashing membrane first side, and a wicking cloth (40, see rejection above for explanation) adhered to the flashing membrane second side; the device having a first edge and a second edge opposite the first edge. While Rizzo notes that the member functions as flashing, it does not disclose the combination with the wall as claimed. Collins discloses a flashing material similar to Rizzo (see Fig. 7) in combination with an inner and outer wall (Fig. 6: 14 and 11, respectively), wherein the first edge of the device (proximate 36) is secured to the inner wall, and the second edge of the device is secured beyond the outer wall (proximate 15). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to use the flashing system in Rizzo in the manner provided in Collins as the purpose of the material in Rizzo is to function as a flashing device and it would operate in the manner as needed with the system in Collins. The language, "such that water between the inner wall and outer wall is drawn through a mortar joint at the base of the outer wall to

Art Unit: 3635

the outside of the outer wall by the wicking action of the wicking cloth without the need for vents" is a statement of intended use of the claimed invention and must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Further, while the combination of the prior art does not disclose the wicking cloth facing up, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to arrange the parts as necessary because rearrangement of parts is considered an obvious matter of design choice. (see *In re Kuhle*, 526 F.2d 553, 188 USPQ 7 (CCPA 1975) (the particular placement of a contact in a conductivity measuring device was held to be an obvious matter of design choice.)

Claim 22: The obvious combination of the prior art provides the system of claim 21, wherein the first edge is secured at a higher elevation on the inner wall than the second edge is secured to the outer wall (see Collins, generally).

Claim 23: The obvious combination of the prior art provides the system of claim 21, further comprising a horizontal support (see Collins Fig. 6: proximate 15) upon which the inner wall and

Art Unit: 3635

outer wall are supported, wherein the device second edge is disposed between and beyond the outer wall and concrete support (as shown in Collins). While Collins does not specifically disclose the support is concrete, the examiner takes Official notice that concrete supports are well known in the art as foundations for such structures.

Claim 24: Rizzo discloses a system for removing water from between an inner wall and an outer wall comprising a combination through-wall masonry flashing and drainage device, the device comprising a flashing membrane (60) having a first side and a second side opposite the first side, a first reinforcing cloth (66) adhered to the flashing membrane first side, a second reinforcing cloth (80) adhered to the flashing membrane second side. The embodiment in Fig. 4 does not disclose the wicking cloth layer, however, the embodiment in Fig. 2 discloses a wicking cloth (38; see Col. 4, lines 10-15 and Col. 3, lines 55-60) adhered to the reinforcing cloth. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to have the wicking cloth with the embodiment in fig. 4 as the embodiments are obvious variants and the materials can be interchanged without departing from the scope of the prior art. While Rizzo notes that the member functions as flashing, it does not disclose the combination with

Art Unit: 3635

the wall as claimed. Collins discloses a flashing material similar to Rizzo (see Fig. 7) in combination with an inner and outer wall (Fig. 6: 14 and 11, respectively), wherein the first edge of the device (proximate 36) is secured to the inner wall, and the second edge of the device is secured beyond the outer wall (proximate 15). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to use the flashing system in Rizzo in the manner provided in Collins as the purpose of the material in Rizzo is to function as a flashing device and it would operate in the manner as needed with the system in Collins. The language, "such that water between the inner wall and outer wall is drawn through a mortar joint at the base of the outer wall to the outside of the outer wall by the wicking action of the wicking cloth without the need for vents" is a statement of intended use of the claimed invention and must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Further, while the combination of the prior art does not disclose the wicking cloth facing up, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to arrange the parts as

Art Unit: 3635

necessary because rearrangement of parts is considered an obvious matter of design choice. (see *In re Kuhle*, 526 F.2d 553, 188 USPQ 7 (CCPA 1975) (the particular placement of a contact in a conductivity measuring device was held to be an obvious matter of design choice.)

Claims 25-27: The prior art provides the claimed invention except, wherein the flashing membrane is a sheet of PVC material (claim 25) polyethylene material (claim 26) or stainless steel material (claim 27), though Rizzo notes the material is copper. Collins discloses the flashing material can be made of any of the above materials (Col. 2, lines 20-30). It would have been obvious at the time the invention was made to a person having ordinary skill in the art as these materials would be functionally equivalent and would perform equally as well.

### ***Response to Amendment***

3. The declarations of J. Lincourt, M. Mahoney, W. Sneed, D. Spino and D. Tresnak under 37 CFR 1.132 filed 19 February 2010 is insufficient to overcome the rejection of claims because: as noted the newly cited prior art above qualifies under 35 USC 102(b) and 103. The structural limitations of the Rizzo reference (cited above) either anticipate or render obvious the claimed invention. Further, no information or data has been



Art Unit: 3635

provided to establish unexpected results or commercial success. In addition, objective evidence of nonobviousness including commercial success must be commensurate in scope with the claims. *In re Tiffin*, 448 F.2d 791, 171 USPQ 294 (CCPA 1971) (evidence showing commercial success of thermoplastic foam "cups" used in vending machines was not commensurate in scope with claims directed to thermoplastic foam "containers" broadly). In order to be commensurate in scope with the claims, the commercial success must be due to claimed features and not due to unclaimed features. *Joy Technologies Inc. v. Manbeck*, 751 F. Supp. 225, 959 F.2d 226, 228, 22 USPQ2d 1153, 1156 (Fed. Cir. 1992) (Features responsible for commercial success were recited only in allowed dependent claims, and therefore the evidence of commercial success was not commensurate in scope with the broad claims at issue.)

The declaration of K. Broad under 37 CFR 1.132 filed 24 September 2008 is sufficient to overcome the rejection of the claims based upon common inventorship of U.S. Patent 6,696,141 as set forth in the last Office action, however the patent is no longer being cited as prior art, therefore rendering the statement moot. The examiner, however, agrees that contents of the declaration are correct.

The declarations of J. Lincourt and under 37 CFR 1.132 filed 24 September 2008 and 27 April 2009 is insufficient to overcome the rejection of claims based upon the Cohen and Healy references as set forth in the last Office action because: the references are no longer being cited as prior art in this Office action rendering the arguments moot.

#### ***Disposition of the Present Case***

4. The present case is being re-opened for prosecution after applicant's appeal filed 08 June 2010. The case is reopened to properly consider affidavits filed throughout prosecution and to reconsider the prior art cited.

#### ***Conclusion***

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to WILLIAM V. GILBERT whose telephone number is (571)272-9055. The examiner can normally be reached on Monday - Friday, 08:00 to 17:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached on 571.272.6777. The fax phone number for the

Art Unit: 3635

organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Richard E. Chilcot, Jr./  
Supervisory Patent Examiner, Art Unit  
3635

/William V Gilbert/  
Examiner, Art Unit 3635